

REMARKS

Claims 1-3, 5-10, and 12-16 are all the claims pending in the application. Claims 5-7 and 12-14 have been withdrawn from consideration.

Submission of verified English translation of the priority document

Concurrent with this Amendment, in order to expedite prosecution, Applicants are submitting a verified English translation of the priority document (Korean Patent Application 10-2002-0075398) to perfect priority.

Allowable Subject Matter

Applicants thank the Examiner for maintaining that claims 3 and 10 contain allowable subject matter, and would be allowable if rewritten in independent form¹. However, Applicants respectfully request the Examiner to hold in abeyance such rewriting of the claims until the Examiner has had a chance to reconsider and withdraw the rejection of the other claims.

Claim Rejections - 35 U.S.C. § 102 based on Gould et al. (U.S. Patent No. 5,563,649)

Claims 1, 2, 8, and 9 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,563,649 to Gould *et al.* ("Gould"). For *at least* the following reasons, Applicants respectfully traverse the rejection.

Applicants submit that claim 1 is not anticipated by Gould. For example, claim 1 relates to an MPEG video decoding method. The method comprises, *inter alia*, determining whether to perform motion compensation on motion-vector-decoded data or not **depending on a value of a decoded motion vector**. The Examiner contends that col. 15, lines 55-67 of Gould disclose the

¹ Applicants note that the Examiner inadvertently states claims 3 and 9 would be allowable on page 7 of the Office Action, but claim 9 is rejected under 35 U.S.C. § 102. Claim 10, which corresponds to claim 3, is correctly indicated as allowable in the Office Action Summary (box 7).

above-noted features of claim 1. See Office Action, pages 3 and 4. Applicants respectfully disagree.

Gould is directed to a video fax system in which compression and decompression are performed at variable frame rates (e.g., Gould's Abstract discloses that "[c]ompression and decompression are each performed in two stages, with a real-time component performed at full-frame rate, and an offline secondary reduced frame-rate component"). In the cited portions of Gould, it is disclosed that based on the type of frames, motion compensation is carried out.

For instance, as it is correctly pointed out in the Office Action, in the case of P frames, the decoded coefficients correspond to differences between the present frame and the motion compensated estimate of last-most occurring reference frame (Office Action, page 4, lines 3-6, and Gould, col. 15, lines 64-67). That is, the determination as to whether to perform motion compensation on the compressed motion sequence elements or not is not based on the value of any decoded motion vectors in Gould.

It appears that the Examiner relies on the case of I frames in Gould to disclose a case where it is determined not to perform motion compensation depending on the value of the decoded motion vector. Gould discloses that "[f]or 'I' frames, **there are no motion vectors**, and the decoded DCT coefficients correspond to blocks of pixel values" (Gould, col. 15, lines 59-61, emphasis added). Since there are no motion vectors for the I frames, the determination of performing motion compensation on the I frames is not dependent on a value of a decoded motion vector, as required by claim 1. Rather, as would be obvious to a skilled artisan, the incoming MPEG bitstream to be decompressed includes a header for each frame in a group of pictures (GOP). This header includes data identifying the type of the frame, i.e., an I-frame, P-frame, or a B-frame.

Based on the identified type of the frame, Gould determines whether to perform motion compensation on the subject frame or not. As such, determining whether to perform motion compensation on motion-vector-decoded data or not **is not** dependent on **a value of a decoded motion vector** in Gould. Therefore, Applicants respectfully submit that Gould does not disclose each and every feature of claim 1 in as complete detail as set forth in the claim. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection.

Claim 8 relates to an MPEG video decoder. The MPEG video decoder comprises, *inter alia*, a motion vector determiner determining whether to perform motion compensation or not **depending on a value of a decoded motion vector**. As such, Applicants submit that claim 8 is patentable for *at least* reasons similar to those given above with respect to claim 1.

Claims 2 and 9 are patentable *at least* by virtue of their dependency.

Claim Rejections - 35 U.S.C. § 102 based on Etoh et al. (U.S. Publication No. 2005/0063466)

Claims 15 and 16 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Publication No. 2005/0063466 to Etoh *et al.* (“Etoh”). For *at least* the following reasons, Applicants respectfully traverse the rejection.

Applicants respectfully submit that Etoh does not qualify as prior art with respect to the instant application. For example, the filing date of the instant application is August 26, 2003. Further, the instant application claims priority to Korean Patent Application 10-2002-0075398 (“KPA ’398”), which was filed on November 29, 2002. The U.S. publication date of the Etoh reference is March 24, 2005. Thus, the Examiner relies on the filing date of the Etoh reference, which is November 29, 2002 (this is the same date as the priority date of the instant application), as Etoh’s effective § 102(e) date. This filing date of the Etoh reference is the date

the international application (PCT/JP02/12556) was filed (Etoh's U.S. publication stems from its national stage entry into the U.S. on June 1, 2004).

Applicants note that 35 U.S.C. § 102(e) requires that for an international application to be accorded a § 102(e) date, it must meet the following three conditions (see MPEP § 706.02(f)):

- (a) an international filing date on or after November 29, 2000;
- (b) designated the United States; and
- (c) published under PCT Article 21(2) in English.

PCT/JP02/12556 was published as WO 03/047270 on June 5, 2003, in **Japanese**. In Example 5 shown in MPEP § 706.02(f), it is clearly stated that “[a]ll references, whether the WIPO publication, the U.S. patent application publication or the U.S. patent, of an international application (IA) that was filed on or after November 29, 2000 but was not published in English under PCT Article 21(2) have no 35 U.S.C. 102 (e) prior art date at all. According to 35 U.S.C. 102 (e), no benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for 35 U.S.C. 102 (e) prior art purposes if the IA was published under PCT Article 21(2) in a language **other than English**, regardless of whether the international application entered the national stage. Such references may be applied under 35 U.S.C. 102 (a) or (b) as of their publication dates, but never under 35 U.S.C. 102 (e)” (emphasis added).

Therefore, Applicants respectfully submit that Etoh does not qualify under 35 U.S.C. § 102(e). Moreover, since the U.S. publication of the Etoh reference (dated March 24, 2005) was published **after** the filing date of the instant application (August 26, 2003), **Etoh does not qualify as prior art under 35 U.S.C. § 102(a) or (b) either**.

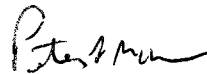
In view of the foregoing, Applicants respectfully submit that Etoh is not valid prior art, and thus, request withdrawal of the improper 35 U.S.C. § 102(e) rejection based on Etoh.

Conclusion

Based on the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Peter A. McKenna
Registration No. 38,551

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: April 22, 2008